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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/467,994      | 12/20/1999  | BRUCE A. YOUNG       | 450.312US1          | 3101             |

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EXAMINER

GREENE, DANIEL L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3621

DATE MAILED: 07/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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|                              |                        |  |                     |  |
|------------------------------|------------------------|--|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> |  | <b>Applicant(s)</b> |  |
|                              | 09/467,994             |  | YOUNG, BRUCE A.     |  |
|                              | <b>Examiner</b>        |  | <b>Art Unit</b>     |  |
|                              | Daniel L. Greene       |  | 3621                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 December 1999.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over and further in view of Shah US 5,028,766 [Shah '766] , Phillips- US 5,839,058 [Phillips '058] and Peters US 5,769,269 [Peters '269].

As per claim 1.

Shah '766 discloses a product dispensed from a vending machine in one location. Col.1, lines 42-44.

Shah '766 does not specifically disclose a product return system, comprising: a return mailer dispensed with the product, the product returnable in the return mailer to a return center; the return center in another location. However, Shah '766 does disclose a system that does require the customer to return a product dispensed from a vending machine. Col. 2, line 8.

Phillips '058 discloses a system that does require the customer to return a product after use. Col. 3, lines 7-12.

Phillips '058 further discloses a return mailer dispensed with the product for returning the product to a predetermined entity. Col. 12, line 51.

Phillips '058 does not specifically disclose a vending machine as providing the POS product. However it is well known and understood in the retail marketing industry POS marketing and distribution of products can be either be by vending machines or station clerks.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate into the vending machine of Shah '766 the product of Phillips '058 to provide another POS outlet and increase the availability of the product to the public.

Phillips '058 does not specifically disclose a return center in another location. However, Phillips '058 does disclose returned by the user, ...by mail, to a predetermined entity. It is inherent in Phillips '058 that "predetermined entity" is another location other than the POS since the phone is being refurbished at the "predetermined entity". Also, "return " is not a limiting claim because it is a nonfunctional description. "A return center" could also be called a "predetermined entity" or a recycle center, etc., and not affect the method of returning an object to a place. Since this difference is only found in the nonfunctional descriptive material and does not alter how the item is returned, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to name a site for receiving returned goods anything they wanted because such data does not alter the limiting concept of utilizing a mailer

and the subjective interpretation of the data does not patent ably distinguish the claimed invention.

As per claim 2.

Shah '766 and Phillips '058 disclose all the limitations of claim 1.

Shah '766 does not specifically disclose a controller containing a database with information on the product, the controller connected to the vending machine and to the return center with transmission links.

Peters '269 discloses a controller containing a database with information on the product, the controller connected to the vending machine and to a Customer Service center with transmission links. Col. 7, lines 1-43.

Peters '269 does not specifically disclose a "return center". However Peters '269 does disclose a Customer Service Center (CSR). The examiner is taking Official Notice that a "return center and a Customer Service Center (CSR) can serve as the same function.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to substitute the "return center" for a CSR since both of them deal with products and customers remote of the POS site.

As per claim 3.

Shah '766 and Phillips '058 disclose all the limitations of claim 1.

Shah '766 does not specifically disclose wherein the product is a media product selected from the group consisting of DVDs, CDs, videotapes, software media and audiotapes.

Peters '269 discloses wherein the product is a media product selected from the group consisting of DVDs, CDs, videotapes, software media and audiotapes. Col. 2, lines 49-56.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to increase the items available to the customer from the Shah '766 vending machine to increase the selection to the customer.

As per claim 4.

Shah '766 and Phillips '058 disclose all the limitations of claim 1.

Shah '766 further discloses wherein the product is rented using a transaction card. Fig. 14A

As per claim 5.

Shah '766 and Phillips '058 disclose all the limitations of claim 1.

Shah '766 does not specifically disclose wherein the vending machine is located in a location selected from the groups consisting of an airport, a railroad station, a bus station, a subway, a store and a hotel.

Peters '269 discloses wherein the vending machine is located in a location selected from the groups consisting of an airport, a railroad station, a bus station, a subway, a store and a hotel. Col. 1, lines 23-35.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place more than one of the Shah '766 vending machine in different locations to increase coverage and revenue.

As per claim 6.

Shah '766 and Phillips '058 disclose all the limitations of claim 1.

Shah '766 does not specifically disclose wherein the product is obtained in a first location, used in a second location and deposited in a collection box in a third location. However, Shah '766 does disclose where a product is obtained in a first location and used in a second location. Col.2, lines 5-8.

Phillips '058 discloses wherein the product is obtained in a first location, used in a second location and deposited in a collection box in a third location. Col. 3, lines 6-25.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate into Shah '766 system, Phillips '058 additional action of depositing in a collection box in a third location after the customer is done with the product to facilitate disposal.

As per claim 7.

Shah '766, Phillips '058 and Peters '269 discloses all the limitations of claim 2.

Shah '766 does not specifically disclose a service agent facility having an automated service agent, the automated service agent having means for accessing the database. However, Shah '766 does disclose a dailless phone 7, which may be connected to a central office or to a manager... Col.3, line25-26

Peters '269 discloses a service agent facility having an automated service agent, the automated service agent having means for accessing the database. Col. 7, lines 1-60.

The element of connecting to the central office or a manger is the equivalent of connecting to an automated service agent because both represent the company and both can serve the same function as the other.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate into Shah '766 system, Peters '269 automated service agent in place of Shah '766 central office or manager contact to facilitate another way to help a customer.

As per claim 8.

Shah '766, Phillips '058 and Peters '269 discloses all the limitations of claim 7.

Shah '766 does not specifically disclose comprising instructions issued by the controller to the return center and to the service agent facility, the instructions providing



information on inventory management. However, Shah '766 does disclose a telephone modem **165** to receive information from a central office, remote manager ...

Peters '269 discloses instructions issued by the controller to the return center and to the service agent facility, the instructions providing information on inventory management via a telephone modem.. Col. 7, lines 1-60.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize a telephone modem to convey information between different locations about the status of inventory to facilitate control over the inventory.

As per claim 9.

Shah '766, Phillips '058 and Peters '269 discloses all the limitations of claim 1.

Shah '766 does not specifically disclose a transaction identifier on the return mailer.

However, the examiner takes Official Notice that it is inherent on return mailers that some form of identification is always present.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to put a transaction identifier on the return mailer.

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As per claim 10.

Shah '766, Phillips '058 and Peters '269 discloses all the limitations of claim 9.

Shah '766 does not specifically disclose wherein the transaction identifier is a scan able code.

However, the examiner takes Official Notice that it is inherent on return mailers that the identifiers are all scan able codes.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the identifiers as scan able codes to facilitate machine reading of the mail and, reduce the need for personnel to manually handle.

As per claim 11.

Shah '766, Phillips '058 and Peters '269 discloses all the limitations of claim 10.

Shah '766 does not specifically disclose the return mailer has pre-paid postage and is pre-addressed to the return center. However, Shah '766 does disclose a storage cartridge with a data strip. Col. 4, lines 9-11

Phillips '058 discloses the return mailer that has data strips that are pre-paid postage and an address for the return center. Col. 6, lines 59-63.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate into Shah '766 data strip, Phillips '058 data representing pre-paid postage and the address of the return center to assist the ease of the customer to return the product.

As per claim 12.

Shah '766, Phillips '058 and Peters '269 discloses all the limitations of claim 1.

Shah '766 further discloses wherein the cover around the product is also a product case. Col. 4, lines 9-11

Shah '766 does not specifically disclose wherein the cover around the product is a return mailer.

However, you can call the case around a product anything you want and it will not alter the fact that it is still a cover. i.e. return mailer, storage cartridge, etc. Since this difference is only found in the nonfunctional descriptive material and does not alter that the item has a cover, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide a cover for the product to protect it.

As per claim 13.

Shah '766, Phillips '058 and Peters '269 discloses all the limitations of claim 1.

Shah '766 does not specifically disclose wherein the product is not returned to the return center.

However, wherein the product is not returned to the return center does not add further limitations to claim 1 and is not considered to be further limiting.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to not provide any action when a product is not returned to the return center.

As per claim 14.

Shah '766, Phillips '058 and Peters '269 discloses all the limitations of claim 1.

Shah '766 does not specifically disclose wherein a product rental fee is defined in a set of product rental terms, further wherein the product rental fee includes fees for non-compliance with the product rental terms. Shah '766 does disclose a flow chart block designated rates and terms for the rental of allowables. Fig. 14A. Shah '766 further discloses refund upon returning the articles. Col. 6, lines 26-40.

The examiner interprets the refund upon returning the article to be the same as fees for non-compliance with the product rental terms and that is included in the initial cost along with the regular product rental fee.

Therefore, Shah '766 does teach about the product rental fee is defined in a set of product rental terms, further wherein the product rental fee includes fees for noncompliance with the product rental terms.

As per claim 15.

Shah '766, Phillips '058 and Peters '269 discloses all the limitations of claim 14.

Shah '766 further discloses determining compliance or non-compliance with the product rental terms, further wherein an additional charge is posted to a consumer account or a future credit to a consumer account is canceled for non-compliance with the product rental terms. Col. 6, lines 15-40.

Shah '766 does not specifically disclose wherein the return center determines the action to be taken.

However, as disclosed in previous claims the rental center can be a central office or a predetermined entity as identified in the prior art and requires no further explanation.

As per claim 16.

Shah '766, Phillips '058 and Peters '269 discloses all the limitations of claim 15.

Shah '766 does not specifically disclose wherein product rental terms include terms related to a specified return date and product condition.

However, Shah '766 does disclose a flow chart block designated rates and terms for the rental of allowables.

The element of "product rental terms" is only limited by the imagination of the designer and therefore non-limiting. PTO's guidelines for examining claimed language require: the examiner must make a determination, whether the claimed invention "as a whole" would have been obvious at the time of the invention to one of ordinary skill in the art. See MPEP 2142. In this pending claim, the examiner submits the particular language does not serve as a limitation for the claim (i.e., terms related to a specified

return date and product condition). A limitation on a claim can be broadly thought of as its ability to make a meaningful contribution to the definition of the invention in a claim.

In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation. See *on re Gulak* 217 USPQ 401 (CAFC 1983), *ex parte Carver*, 227 USPQ 465

(*BdPatApp&Int* 1985) and in *re Lowry*, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include any type or kind of rental terms (i.e., a specified return date, product condition, early return, etc.) in their contract that they felt would benefit their company.

As per claim 17.

Shah `766, Phillips `058 and Peters `269 discloses all the limitations of claim 16.

Shah `766 does not specifically disclose wherein the database contains information selected from the group consisting of a transaction identifier, product title, product dispense date, specified return date, product condition, product rental fee and product purchase price.

Shah `766 does disclose the use of databases by the central data center for interacting with each station. Col. 3, lines 52-54.

Peters `269 discloses databases and the uses and contents thereof. Col. 5,6,7.

The element about the information contained in a database is only limited by the imagination of the designer and therefore non-limiting. PTO's guidelines for examining claimed language require: the examiner must make a determination, whether the claimed invention "as a whole" would have been obvious at the time of the invention to one of ordinary skill in the art. See MPEP 2142. In this pending claim, the examiner submits the particular language does not serve as a limitation for the claim (i.e., terms related to transaction identifier, product title, product dispense date, specified return date, product condition, product rental fee and product purchase price.). A limitation on a claim can be broadly thought of as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation. See *on re Gulak* 217 USPQ 401 (CAFC 1983), *ex parte Carver*, 227 USPQ 465 (BdPatApp&Int 1985) and *in re Lowry*, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include any type or kind of data (i.e., transaction identifier, product title, product dispense date, specified return date, product condition, product rental fee and product purchase price, etc.) in their databases that they felt the company would need to track and use to better control their business.

As per claim 18.

Shah `766, Phillips `058 and Peters `269 discloses all the limitations of claim 17.

Shah `766 does not specifically disclose wherein the return center determines compliance with the specified return date by noting the actual return date and comparing the actual return date with the specified return date in the database.

Shah `766 does disclose determining compliance or non-compliance with the product rental terms, further wherein an additional charge is posted to a consumer account or a future credit to a consumer account is canceled for non-compliance with the product rental terms. Col. 6, lines 15-40.

The element of describing that the non-compliance with the product rental terms includes determining whether or not the product was returned within the rental period specified is inherent. This can only be done by noting the actual return date and comparing the actual return date with the specified return date in the database.

Shah `766 does not specifically disclose wherein the return center determines the action to be taken.

However, as disclosed in previous claims the rental center can be a central office or a predetermined entity as identified in the prior art and requires no further explanation.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to determine compliance with the specified return date



by noting the actual return date and comparing the actual return date with the specified return date in the database.

As per claim 19.

Phillips `058 discloses:

A method of doing business, comprising: providing a media product at one location, the media product dispensed with a return mailer; the return of the media product in the return mailer to another location, the return mailer depositable with a third-party delivery service. Col. 3, lines 6-28.

Phillips `058 does not specifically disclose the return mailer disposable with a third-party delivery service. However, Phillips `058 does disclose as per Fig.1 a cover containing preaddressed mailing label with postage prepaid **55**. It is inherent that the United States Postal Service is a third-party delivery service.

Phillips `058 does not specifically disclose "for rent" . However, Phillips `058 does disclose a specific period of use after which the media product is required to be returned to a predetermined entity. Col. 3, lines 20-25.

The element "for rent" is equivalent to paying for "a specific period of use" is one in the same and requires no further explanation.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the postal service as a third-party delivery service to take advantage of their drop off points throughout the United States.

As per claim 20.

Phillips '058 discloses wherein a unique code identifies the media product. Fig.1,  
**57.**

Phillips does not specifically disclose wherein a unique code identifies the rental location and rental date.

However, the information contained in a unique code is only limited by the imagination of the designer and therefore non-limiting. PTO's guidelines for examining claimed language require: the examiner must make a determination, whether the claimed invention "as a whole" would have been obvious at the time of the invention to one of ordinary skill in the art. See MPEP 2142. In this pending claim, the examiner submits the particular language does not serve as a limitation for the claim (i.e., terms such as the rental location and rental date.). A limitation on a claim can be broadly thought of as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation. See on re Gulak 217 USPQ 401 (CAFC 1983), ex parte Carver, 227 USPQ 465 (BdPatApp&Int 1985) and in re Lowry, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include any type or kind of data (i.e., the rental location and rental date) in their code that they felt the company would need to track and use to better control their business.

As per claim 21.

Phillips '058 discloses all the limitations of claim 20.

Phillips '058 discloses the method further comprising storing information about the media product on a database. Fig. 3, **98**.

Phillips does not specifically disclose information about the rental location and rental date on a database.

However, the information contained in a database is only limited by the imagination of the designer and therefore non-limiting. PTO's guidelines for examining claimed language require: the examiner must make a determination, whether the claimed invention "as a whole" would have been obvious at the time of the invention to one of ordinary skill in the art. See MPEP 2142. In this pending claim, the examiner submits the particular language does not serve as a limitation for the claim (i.e., terms such as rental location and rental date). A limitation on a claim can be broadly thought of as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation. See on re Gulak 217 USPQ 401 (CAFC 1983), ex parte Carver, 227 USPQ 465 (BdPatApp&Int 1985) and in re Lowry, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include any type or kind of data (i.e., the rental

location and rental date.) in their databases that they felt the company would need to track and use to better control their business.

As per claim 22.

Phillips '058 discloses all the limitations of claim 21.

Phillips '058 further discloses issuing credit or canceling additional charges depending on product return date. Col. 19, lines 62-67, Col. 20, lines 1-5

Phillips '058 does not specifically disclose issuing credit or canceling additional charges depending on product condition.

However, that the issuing of credit or canceling of additional charges depending on product condition or any other type of contract liabilities is only limited by the imagination of the designer and therefore non-limiting. PTO's guidelines for examining claimed language require: the examiner must make a determination, whether the claimed invention "as a whole" would have been obvious at the time of the invention to one of ordinary skill in the art. See MPEP 2142. In this pending claim, the examiner submits the particular language does not serve as a limitation for the claim (i.e., issuing credit or canceling additional charges depending on product condition). A limitation on a claim can be broadly thought of as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation. See *on re Gulak* 217 USPQ 401 (CAFC 1983), *ex parte Carver*, 227 USPQ 465 (BdPatApp&Int 1985) and in *re Lowry*, 32 USPQ2d 1031 (CAFC 1994)

where language provided certain limitations because of specific relationships required by the claims.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include any type or kind of contract liability (i.e., issuing credit or canceling additional charges depending on product condition.) to protect their products and provide incentive for customers to not destroy their product.

As per claim 23.

Shah '766 discloses a method of renting media products, comprising: consumer activity, wherein the consumer activity includes a vending machine transaction and a product return step; and provider activity, wherein the provider activity includes return center activity . Col. 3, lines 12-49.

Shah '766 does not specifically disclose a service agent.

However Shah '766 does disclose a dailless phone 7, which may be connected to a central office or to a manger for use in an emergency or occurrence of problems. Col. 3, lines 25-27.

The element of "a service agent" serves the same purpose and function as a central office or a manger for use in an emergency or occurrence of problems via a phone at the vending machine.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide the ability of the customer to get help be it

either through a service center or a central office or a manager to handle any emergencies or problems.

As per claim 24.

Shah '766 discloses all the limitations of claim 23.

Shah '766 further discloses wherein a central controller having a database coordinates the consumer activity and the provider activity, the database containing information on the vending machine transaction and a product return date. Fig. 3, Col. 3, lines 50-60.

Shah '766 does not specifically disclose a product condition.

However, the additional data of product condition or any other type of data is only limited by the imagination of the designer and therefore non-limiting. PTO's guidelines for examining claimed language require: the examiner must make a determination, whether the claimed invention "as a whole" would have been obvious at the time of the invention to one of ordinary skill in the art. See MPEP 2142. In this pending claim, the examiner submits the particular language does not serve as a limitation for the claim (i.e. product condition). A limitation on a claim can be broadly thought of as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation. See *on re Gulak* 217 USPQ 401 (CAFC 1983), *ex parte Carver*, 227 USPQ 465 (BdPatApp&Int 1985) and in

re Lowry, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include any type or kind of additional data (i.e., product condition) to facilitate tracking and decision making for the company.

As per claim 25.

Shah '766 discloses all the limitations of claim 24.

Shah '766 further discloses statistics of transaction records that it receives. Col. 3, lines 55-56

Shah '766 does not specifically disclose the vending machine transaction is entered into the database with a transaction identifier.

However, the element of identifying data by giving it a name is only limited by the imagination of the designer and therefore non-limiting. PTO's guidelines for examining claimed language require: the examiner must make a determination, whether the claimed invention "as a whole" would have been obvious at the time of the invention to one of ordinary skill in the art. See MPEP 2142. In this pending claim, the examiner submits the particular language does not serve as a limitation for the claim (i.e. transaction identifier). A limitation on a claim can be broadly thought of as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation. See on re Gulak 217

USPQ 401 (CAFC 1983), ex parte Carver, 227 USPQ 465 (BdPatApp&Int 1985) and in re Lowry, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to identify the data from each of the remote stations by names that are familiar to the company personal.

As per claim 26.

Shah '766 discloses all the limitations of claim 23.

Shah '766 further discloses wherein the vending machine transaction comprises: a consumer activating a vending machine with a transaction card; the consumer selecting a product; and the product dispensing from the vending machine. Fig. 1.

Shah '766 does not specifically disclose the product dispensing from the vending machine with a return mailer.

Phillips '058 discloses a product that includes a return mailer that is available at locations that utilize vending machines as well as sales people to dispense items.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the product with the mailer as taught by Phillips '058 into the vending machines taught by Shah '766 to increase the point of sales available to the customers.



As per claim 27.

Shah '766 and Phillips '058 disclose all the limitations of claim 26.

Shah '766 further discloses wherein the product is rented using a transaction card. Fig. 14A.

Shah '766 does not specifically disclose wherein the transaction card is charged for a full purchase price or a rental price.

Phillips '058 discloses wherein the transaction card is charged for a full purchase price or a rental price. Col. 19, lines 50-65.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to charge for a full purchase price or a rental price depending on the customer's choice.

As per claim 28.

Shah '766 and Phillips '058 disclose all the limitations of claim 27.

Phillips '058 discloses issuing a credit for a difference between a rental price and a purchase price or canceling a future charge when the product is return in good condition and on time. Col. 19, lines 60-67, Col. 20, lines 1-5.

Phillips does not specifically disclose wherein the return center activity comprises: opening the return mailer; inspecting the product inside the return mailer to determine if the product is in good condition; comparing information in the database with the product inside the return mailer.

However, for the recycle center to be able to determine whether or not to charge for the deposit guaranteeing return of the telephone they would have to somehow, open the return mailer, inspect the product and compare information in the database with the product inside the return mailer.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to open the return mailer, inspect the product and compare information in the database with the product inside the return mailer to determine whether to issue a credit for the difference between a rental price and a purchase price or cancel a future charge when the product is return.

As per claim 29.

Shah '766 and Phillips '058 disclose all the limitations of claim 28.

Phillips does not specifically disclose wherein a pro-rated credit is issued when the product is returned late or in less than good condition.

However, the element "pro-rated" credit is an accounting means that is only limited by the imagination of the designer and therefore non-limiting. PTO's guidelines for examining claimed language require: the examiner must make a determination, whether the claimed invention "as a whole" would have been obvious at the time of the invention to one of ordinary skill in the art. See MPEP 2142. In this pending claim, the examiner submits the particular language does not serve as a limitation for the claim (i.e. "pro-rated" credit). A limitation on a claim can be broadly thought of as its ability to make a meaningful contribution to the definition of the invention in a claim. In other

words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation. See on re Gulak 217 USPQ 401 (CAFC 1983), ex parte Carver, 227 USPQ 465 (BdPatApp&Int 1985) and in re Lowry, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to set up any type of accounting means, i.e.( pro-rated credit, late fee, non-compliance fee) to provide for a customer not following the terms of the companies contract.

As per claim 30.

Peters '269 discloses an apparatus for dispensing products, comprising: means for selecting a particular product; means for dispensing the particular product to a customer; means for identifying the particular product; and means for recording a transaction date in a database. Col. 2 &3.

Peters '269 does not specifically disclose dispensing the particular product together with a return mailer to a customer.

However, Phillips '058 discloses a product that includes a return mailer that is available at locations that utilize vending machines as well as sales people to dispense items.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the product with the mailer as taught by

Phillips '058 into the vending machines taught by Peters '269 to increase the point of sales available to the customers.

As per claim 31.

Peters '269 and Phillips '058 discloses all the limitations of claim 30.

Peters '269 further discloses wherein the means for selecting and depositing a particular product is a vending machine. Abstract.

As per claim 32.

Peters '269 and Phillips '058 discloses all the limitations of claim 31.

Peters '269 further discloses a means for identifying the particular product; and means for recording a transaction date in a database. Col. 2 &3.

Peters '269 does not specifically disclose the means for identifying the product and rental date in a unique code, the unique code enterable in the database.

However, Phillips '058 discloses the means for identifying the product and rental date with a unique code, the unique code enterable in the database. Fig.1, **55,57**.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate into Peters '269 means for identifying the particular product with Phillips '058 means for identifying the product and rental date with a unique code, the unique code enterable in the database.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Junger-US 6,085,172- EFFICIENT HANDLING OF PRODUCT RETURN  
TRANSACTIONS

Shore et al.- US 4,598,810- VENDING AND ACCEPTING RETURN

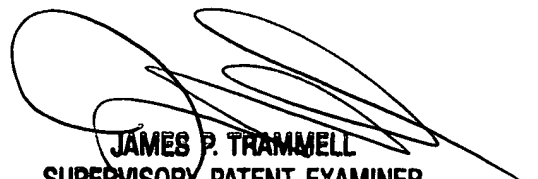
Girard et al.-US 5,742,883- PRODUCT INTEGRATED RETURN MAILER

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703.306.5539. The examiner can normally be reached on M-Thurs. (8:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on 703.305.9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305-7687 for regular communications and 703.305.7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308-1113.

DLG  
June 24, 2002

  
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